



Patent  
Attorney's Docket No. 003510-110

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	MAIL STOP AMENDMENT
Kazuhiro FUJIMAKI et al.	)	
Application No.: 09/932,975	)	Group Art Unit: 1752
Filed: August 21, 2001	)	Examiner: Barbara Gilliam
For: IMAGE RECORDING MATERIAL	)	Confirmation No.: 6820

**RESPONSE AND SUBMISSION OF TERMINAL DISCLAIMER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:


In the Official Action mailed February 25, 2004, the Examiner raised a single "obviousness-type" double patenting rejection over certain claims of pending U.S. Patent Application No. 10/223,700 in view of U.S. Patent No. 6,566,035. The '700 application has now issued as U.S. Patent No. 6,702,437 B2. Therefore, to advance the prosecution in this application, provided herewith is a Terminal Disclaimer which disclaims the terminal portion of any patent issuing on the present application that would extend beyond the statutory term of the '437 patent. In addition, applicants are concurrently submitting a Third Information Disclosure Statement which identifies the documents which appear on the face of the '437 patent. In this respect, applicants also note that a Second Information Disclosure Statement was filed on February 26, 2004, and applicants request that the Examiner also consider and acknowledge the documents identified in that Statement as well.

Since all matters raised in the Action have been met by the instant response, applicants respectfully request reconsideration and allowance of the present application.

Should the Examiner wish to discuss any aspect of the present application, she is invited to contact the undersigned attorney at the number provided below.

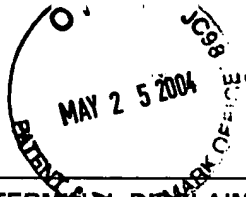
Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:   
Robert G. Mukai  
Registration No. 28,531

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Date: May 25, 2004



**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

003510-110

In re Patent Application of: Kazuhiro FUJIMAKI et al.

Application No.: 09/932,975

Filed: August 21, 2001

For: IMAGE RECORDING MATERIAL

The owner\*, FUJI PHOTO FILM CO., LTD.

of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,702,437. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

Robert G. Mukai  
Signature

May 25, 2004  
Date

Robert G. Mukai  
Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this statement. See MPEP § 324.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 003510-110 Patent #

MAIL STOP AMENDMENT

In re Patent Application of  
Kazuhiro FUJIMAKI et al.  
Application No.: 09/932,975  
Filing Date: August 21, 2001  
Title: IMAGE RECORDING MATERIAL

Group Art Unit: 1752  
Examiner: Barbara Gilliam  
Confirmation No.: 6820

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☒ A Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☒ \$110.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☒ Also enclosed is/are a Third Information Disclosure Statement.
- \_\_\_\_\_
- \_\_\_\_\_
- \_\_\_\_\_
- \_\_\_\_\_
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted \_\_\_\_\_
- \_\_\_\_\_
- on \_\_\_\_\_
- for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least \_\_\_\_\_, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	20	MINUS 20 =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims	6	MINUS 6 =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
<b>TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT</b>					<b>\$ 0.00</b>

- ☒ A check in the amount of \$ 290.00 is enclosed for the fee due.
- ☐ Charge \_\_\_\_\_ to Deposit Account No. 02-4800.
- ☐ Charge \_\_\_\_\_ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.


Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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Date: May 25, 2004

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